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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,588

11/21/2003

Achim Ansmann

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COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER

KANTAMNENI, SHOBHA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/719,588	<b>Applicant(s)</b> ANSMANN ET AL.	
	<b>Examiner</b> Shobha Kantamneni	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 2-5, 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/08/2008 has been entered.

Applicant's amendment filed on 04/08/2008, wherein claims 2-5, and 14-17 have been amended, and new claims 18-21 have been added. Applicant's amendment also cancelled claims 1, and 13.

Applicant's amendment by cancelling claims 1, 13 overcomes the rejection of claims 1, 13 under 35 U.S.C. 102(b) as being anticipated by Garland et al. (Journal of the American Chemical Society, Sept, 1925, pages 2333-2340, PTO-1449).

Claims 2-5, 14-21 are examined herein.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to claims 16-17 filed on 09/17/2007, and new claims 18-19 filed on 04/08/2008 has been fully considered but is deemed to insert new matter into the claims, since the specification as originally filed does not provide support for the limitation, "wherein the amount of the compound of formula (III) or formula (IV) present in the pharmaceutical composition is from 0.1 % to 50 % by weight", and "wherein the amount of the compound of formula (III) or formula (IV) present in the pharmaceutical composition is from 0.1 % to 30 % by weight". The original specification merely discloses that the dicyclic compounds are suitable for use in pharmaceutical preparations. See page 3, lines 19-20; page 4, lines 18-20. Accordingly, the claimed subject matter has not been described in such a way as to reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed were actually in possession of such as pharmaceutical composition having the particular amounts, and thus the claim fails to meet the written description.

### ***Response to Arguments***

Applicant's arguments have been considered, but not found persuasive. Applicant argues that "page 3, lines 17-19, and page 4, lines 15-20, the nonaromatic dicyclic compounds are described as useful in both cosmetic or pharmaceutical preparations.... Therefore, no new matter is added." This argument is considered, but not found persuasive because page 4, lines 15-20, with the specific amounts refer only to cosmetic preparations and not to pharmaceutical preparations. It is pointed out that

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cosmetic and pharmaceutical preparation employ different amounts of compounds. The amounts of compounds in the cosmetic preparation are disclosed. The amounts of compounds in the pharmaceutical preparation are not disclosed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garland et al. (Journal of the American Chemical Society, Sept, 1925, pages 2333-2340, PTO-1449), and in view of Luisi (WO 8900077, PTO-1449).

Garland et al. disclose composition comprising 1-methyl-2-cyclohexyl-cyclohexane, and 1-ethyl-2-cyclohexyl-cyclohexane.

Garland et al. does not teach the particular compound of formula (III), or formula (IV) as in claims 2-3, and 14-15, and the employment of the compound of formula (III) or formula (IV) in a cosmetic and pharmaceutical composition.

Garland et al. do not teach the amounts of bicyclohexyl compounds in the compositions therein as 0.1 % to 50 % by weight.

Luisi teaches that bicyclohexyl compounds are employed in pharmaceutical preparations as solvents. See page 9; page 17, claim 5.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to the particular instant compounds of formula (III) or (IV) in the prior art composition of Luisi because 1) Garland et al. teaches that alkyl substituted bicyclohexyl compounds are known in the art, and 2) Luisi teaches that cycloalkanes which include bicyclohexyl compounds, and cyclopentane are known to be useful as solvents in pharmaceutical preparation.

Therefore, one of ordinary skill in the art would have been reasonably expected that the instant particular alkyl substituted bicyclohexyl or bicyclopentyl compounds of formula (III), or (IV), would have same or substantially similar usefulness as solvents in pharmaceutical preparation such as bicyclohexyl compounds taught by Luisi, based on the reasonable expectation that structurally similar species usually have similar properties. See, e.g, Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also Deuel, 51 F.3d at 1558, 34 USPQ2d at 1214, and if the claimed invention and the structurally similar prior art species share any useful property, that will generally be sufficient to motivate an artisan of ordinary skill to make the claimed species. In fact, similar properties may normally be presumed when compounds are very close in structure. Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904, as noted in MPEP 2144.

It would have been obvious to a person of ordinary skill in the art at the time of invention to determine or optimize parameters such as effective amounts of the bicyclohexyl compounds employed in the composition of Garland et al. to obtain a pharmaceutical composition, a cosmetic composition, since Luisi teaches that

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bicyclohexyl compounds are known to be used as solvents in pharmaceutical composition.

One having ordinary skill in the art at the time the invention was made would have been motivated to determine the effective amounts of bicyclohexyl compounds employed in the compositions, since the optimization of effective amounts of known agents, is considered well in the competence level of an ordinary skilled artisan in cosmetic and pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments have been considered, but not found persuasive.

Applicant argues that "From the lengthy list of aromatic and aliphatic organic solvents in Luisi, the Examiner has located an unsubstituted bicyclohexyl compound which allegedly represents a comparable compound to Applicants hexamethyl-substituted compounds. When considering the reference as a whole, however, there is no teaching, suggestion, or line of reasoning provided to one skilled in the art to select the unsubstituted bicyclohexyl compound of Luisi over all the other possible compounds disclosed." These arguments have been considered, but not found persuasive. Luisi teaches that cycloalkanes which include bicyclohexyl compounds, and cyclopentane are known to be useful as solvents in pharmaceutical preparation. Thus, considering Luisi

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reference as a whole one would have been motivated to employ bicyclohexyl compounds, and cyclopentyl compounds as solvents in pharmaceutical preparations. Further, according to Garland et al., alkyl substituted bicyclohexyl compounds are known in the art. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of the invention to the particular instant alkyl substituted bicyclohexyl compounds of formula (III) or (IV) in the prior art composition of Luisi because 1) Garland et al. teaches that alkyl substituted bicyclohexyl compounds are known in the art, and 2) Luisi teaches that cycloalkanes which include bicyclohexyl compounds, and cyclopentane are known to be useful as solvents in pharmaceutical preparation.

Therefore, one of ordinary skill in the art would have been reasonably expected that the instant particular compound of formula (III), or (IV), would have same or substantially similar usefulness as solvents in pharmaceutical preparation, based on the reasonable expectation that structurally similar species usually have similar properties. See, e.g, Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also Deuel, 51 F.3d at 1558, 34 USPQ2d at 1214, and if the claimed invention and the structurally similar prior art species share any useful property, that will generally be sufficient to motivate an artisan of ordinary skill to make the claimed species. In fact, similar properties may normally be presumed when compounds are very close in structure. Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904, as noted in MPEP 2144.

### ***Conclusion***

No claims are allowed.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Friday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D  
Patent Examiner  
Art Unit : 1617

/SREENI PADMANABHAN/  
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